

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): David WENDER

Group Art Unit: 3691

Serial No.: 10/788,506

Examiner: Muriel S. TINKLER

Filed: February 26, 2004

Confirmation No. 7427

For: METHOD OF EVALUATING AN OPTION SPREAD

**PETITION FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(B)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is to request reconsideration of the patent term adjustment calculation indicated in the Notice of Allowance under Rule 705(b) for the captioned application.

On December 9, 2010, the USPTO mailed a Determination of Patent Term Adjustment under 35 U.S.C. §154(b) (Form PTOL-85) with the Notice of Allowance. According to the USPTO's Determination, the above-referenced application should be entitled to a period of 921 days of Patent Term Adjustment (PTA). This application is not subject to a terminal disclaimer.

Applicant for U.S. Patent Application Serial No. 10/788,506 (the "506 Application") respectfully requests recalculation of the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) (Form PTOL-85) mailed December 9, 2010, for the reasons detailed herein. In particular, Applicant respectfully request recalculation of the patent term adjustment due to examination delay under Rule 703 from 961 days to **1215 days**, plus an additional period of **365 days** of patent term adjustment for delay under 35 U.S.C. §154(b)(1)(B), with the Applicant being entitled to an additional period for patent term adjustment if a patent issues from the '506 application more than 4 months after payment of the issue fee under 37 C.F.R. §1.703(a)(6).

For the reasons set forth below, patentee respectfully requests that the patent term adjustment be changed to **1215 days**, plus an additional period of **365 days** of patent term adjustment for delay under 35 U.S.C. §154(b)(1)(B) (with the Applicant being entitled to an additional period for patent term adjustment if a patent issues from the '506 application more than 4 months after payment of the issue fee under 37 C.F.R. §1.703(a)(6)). The Commissioner is hereby authorized to charge the \$200 fee required by Rule 18(e) and any other fees which may be required for consideration of this paper to Deposit Account No. **50-3732**, Order No. 16908-105002.

Calculation of Periods for Patent Term Adjustment

USPTO Delay Under 35 U.S.C. §154(b)(1)(A)(i)

Pursuant to 35 U.S.C. §154(b)(1)(A)(i), Applicant is entitled to patent term adjustment for failure by the USPTO to mail an action under 35 U.S.C. § 132 not later than 14 months from the date on which an application was filed under 35 U.S.C. § 111(a) ("14-month delay"). The '506 application was filed on February 26, 2004. The first office action by the USPTO for the '506 application was mailed on April 23, 2008. The USPTO calculated a period of **1093 days** for delay under § 154(b)(1)(A)(i) for the period beginning April 26, 2005 (*i.e.*, 14 months from the June 20, 2003 filing of the application under 35 U.S.C. § 111(a)) until the mailing of the first office action on April 23, 2008.

USPTO Delay Under 35 U.S.C. §154(b)(1)(A)(ii)

Pursuant to 35 U.S.C. §154(b)(1)(A)(ii), Applicant is entitled to patent term adjustment for failure by the USPTO to respond to a reply under § 132, or to an appeal taken under § 134, within 4 months after the date on which the reply was filed or the appeal was taken ("4-month delay"). The USPTO contends that the Applicant is only eligible for a period of **3 days** for delay under § 154(b)(1)(A)(ii) for the period beginning February 28, 2010 (four months after Applicant's October 30, 2009 Response after Non-Final Action) and ending March 3, 2010 (*i.e.*, the date the Non-Final Rejection was mailed).

The USPTO's calculations did not take into account an **additional** period of **119 days** of delay by the USPTO under 35 U.S.C. §154(b)(1)(A)(ii) from August 12, 2010 (four months after

Applicant's April 12, 2010 Response after Non-Final Action) until the mailing of the Notice of Allowance on December 9, 2010. The USPTO mailed a Final Office Action on July 23, 2010, but this very rejection was withdrawn and vacated by the Examiner pursuant to a telephonic interview with the Examiner on August 18, 2010, a written summary of the interview by the Examiner was mailed on August 24, 2010. As stated in the interview summary, the Examiner withdrew the Final Office Action because the Examiner agreed that the combined references do not teach all limitations of the independent claims. Accordingly, Applicants respectfully submit that the Final Office Action Final Rejection of July 23, 2010 should not be considered as a response by the USPTO to Applicants' submissions of April 12, 2010 for the purpose of calculating patent term adjustment. Applicant's representative spoke with Kery Fries of the Office of Patent Legal Administration, who confirmed to Applicant's representative that, for the purposes of calculating term adjustment, the withdrawn and vacated July 23, 2010 Final Rejection should be treated as never having issued.

Applicant therefore respectfully submits that, because the July 23, 2010 Final Rejection was withdrawn and vacated, that the time period for calculating the 4-months in which the USPTO had to reply under § 132 began with the Applicant's April 12, 2010 Response after Non-Final Action, and the adjustment for failure by the USPTO to respond ran from 4 months after that Response until the Notice of Allowance. Accordingly, Applicant respectfully submits that, in addition to the **3 days** outlined above, Applicant is entitled to an **additional 119 days** for delay under § 154(b)(1)(A)(ii) for the period beginning August 12, 2010 (four months after Applicant's April 12, 2010 Response after Non-Final Action) and ending on December 9, 2010 (*i.e.*, the date of the Notice of Allowance).

Applicant Delay Under 35 U.S.C. §154(b)(2)(C)(ii)

According to 35 U.S.C. §154(b)(2)(C)(ii), the reduction in PTA is based on "any periods of time in excess of three-months that are taken to respond to a notice from the Office making any rejection, objection, argument or other request, measuring such three-month period from the date the notice was given or mailed to the applicant." The USPTO calculated a total of **175 days** of Applicant delay.

USPTO Delay Under 35 U.S.C. §154(b)(1)(B)

The USPTO states on its website that “‘B’ delay is always calculated at the time that the issue notification letter is generated and an issue date has been established.”¹ Therefore, Applicant will have a separate opportunity under 37 C.F.R. §1.704(d) to address the USPTO’s calculation of “B Delay” following issuance of a patent from this application. However, to the extent the USPTO may require Applicant to address any discrepancies regarding patent term adjustment calculations based on “B Delay” in this petition, Applicant respectfully submits that that the present application is entitled to an additional period of **365 days** of patent term adjustment for delay under 35 U.S.C. §154(b)(1)(B).

The calculations provided with the Notice of Allowance do not take into account any USPTO delay under 35 U.S.C. §154(b)(1)(B) for failure of the USPTO to issue a patent within 3 years after the actual filing date of the application (“B delay”). The period of B delay does not include any time after the submission of an RCE². The ‘506 application was filed on February 26, 2004 and an RCE was filed on April 23, 2009. Therefore, Applicants are entitled to **787 days** of B Delay, minus a period of **422 days** (from February 26, 2007 (3 years after the February 26, 2004 filing date) and ending on April 23, 2008 (the date of the mailing of the first office action)) of overlapping days under 35 U.S.C. §154(b)(2)(A), for a period of **365 additional days** of patent term adjustment.

Summary of Requested Correction to PTA

Applicants respectfully submit that the patent term adjustment for the ‘506 application should be the sum of the days of the 14-month delay and the two separate 4-month delays which is **1215 days**, minus period of Applicant delay, which accounts for **175 days**, which in this case results in **1040 days** of term adjustment, plus an additional period of **365 days** of patent term adjustment for delay under 35 U.S.C. §154(b)(1)(B), with the Applicant being entitled to an additional period for patent term adjustment if a patent issues from the ‘506 application more than 4 months after payment of the issue fee under 37 C.F.R. §1.703(a)(6).

¹ See http://www.uspto.gov/patents/process/search/public_pam/guidance/pta_calc_explanation.jsp (a copy of which is attached as Exhibit A).

² Applicant note that the calculation provided on PAIR for this application (a copy of which is attached as Exhibit B) indicates that the USPTO’s current calculation for B Delay to be zero.

AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 16908-105002. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 16908-105002. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 16908-105002.

Respectfully submitted,
King & Spalding, LLP

Dated: January 26, 2011

By: /Scott Kolassa/
Joseph D. Eng Jr. / Scott Kolassa
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EXHIBIT A

United States Patent and Trademark Office

An Agency of the Department of Commerce

PTA Calculation

EXPLANATION OF PATENT TERM ADJUSTMENT CALCULATION

- [What am I viewing? \(#what_viewing\)](#)
- [What do I do if I do not agree with the patent term adjustment determination? \(#what_to_do\)](#)
- [What do I do if I have a question about PAIR or PTA calculation? \(#what_question\)](#)

1. What am I viewing?

Applicants are viewing the Patent Applicant Information Retrieval (PAIR) screen which displays the calculated adjustment to the term of the patent. All calculations displayed on the PAIR screen are determined by a computer program that uses the information recorded in the Office's automated patent application information system (the Patent Application Location and Monitoring system or PALM). The computer program will determine the amount of adjustment to the term of patent pursuant to 35 U.S.C. § 154(b) and 37 CFR 1.702-1.705. The computer program will perform the Patent Term Adjustment (PTA) calculations twice. The first calculation will be performed when the Office enters or mails the Notice of Allowance and the second calculation will be performed when the Office enters or mails the Issue Notification Letter.

The PAIR screen displays a series of entries related to the specific application which is being evaluated to ascertain whether the application will receive an adjustment to the term of the patent.

The specific entries are as follows:

(1) APPLICATION FILING DATE. The APPLICATION FILING DATE entry reflects the original filing date of the application and not the date that the application became eligible for adjustment of the patent term due to examination delay. Plant and utility patents issuing on applications filed on or after May 29, 2000 are eligible for Patent Term Adjustment provisions of 35 U.S.C. § 154(b) (amended, effective May 29, 2000) and 37 CFR 1.702-1.705. This applies to international applications that have an international filing date of May 29, 2000 or later.

(2) ISSUE DATE. The ISSUE Date entry reflects the date the application will issue as a patent, that is the date the patent is granted.

(3) "A" DELAYS. This entry reflects adjustments to the term of the patent based upon USPTO delays pursuant to 35 U.S.C. § 154(b)(1)(A)(i)-(iv) and the implementing regulations 37 CFR 1.702(a) & 37 CFR 1.703(a). An "A" delay may occur prior to the notice of allowance and be included in the PTA determination accompanying the notice of allowance or may occur after the entry or mailing of the notice of allowance and be included in the PTA determination in the issue notification letter.

(4) "B" DELAYS. This entry reflects adjustments to the term of the patent based upon the patent failing to issue within three years of the actual filing date of the application in the United States. See 35 U.S.C. § 154(b) and implementing regulations 37 CFR 1.702(b) & 1.703(b). "B" delay is always calculated at the time that the issue notification letter is generated and an issue date has been established.

(5) "C" DELAYS. This entry reflects adjustments to the term of the patent based upon USPTO delays pursuant to 35 U.S.C. § 154(C)(i)-(iii) and implementing regulations 37 CFR 1.702 (c)-(e) & 1.703(c)-(e). These delays include delays caused by interference proceedings, secrecy orders, and successful appellate reviews.

(6) OVERLAPPING DAYS BETWEEN "A" AND "B" OR "A" AND "C". This entry reflects the calculation of overlapping delays consistent with the Federal Circuit's interpretation of 35 U.S.C. § 154(b)(2)(A) in *Wyeth v. Kappos*. Specifically, this entry reflects the summation of the number of days that an "A" delay occurred on the same calendar day with either a "B" delay or a "C" delay. The number of days determined to be overlapping will reduce the summation of the number of days calculated for "A" delays, "B" delays and "C" delays.

(7) NONOVERLAPPING USPTO DELAYS. This entry reflects the overall summation of the USPTO delays minus any overlapping days. Particularly, it includes the following: ("A" delays + "B" delays + "C" delays) - (the number of calendar days overlapping between "A" delays and "B" delay + the number of calendar days overlapping between "A" delays and "C" delays).

This entry does not reflect the number of days of applicant delays pursuant to 35 U.S.C. § 154(b)(2)(C) and 37 CFR 1.704(b) and 37 CFR 1.704(c)(1)-(11).

(8) PTO MANUAL ADJUSTMENTS. This entry reflects the USPTO personnel adjusting the calculation to increase or decrease the patent term adjustment based upon either an application for patent term adjustment pursuant to 37 CFR 1.705(b) or a request for reconsideration of the patent term adjustment under 37 CFR 1.705(d). In addition, USPTO may reduce the PTA determination in response to a letter of good faith and candor regarding PTA advising the USPTO that the USPTO may have granted more PTA than applicant/patentee is entitled.

(9) APPLICANT DELAYS. This entry reflects adjustments of the patent term due to the Applicant's failure to engage in reasonable efforts to conclude prosecution of the application for the cumulative period in excess of three months. See 35 U.S.C. § 154(b)(2)(C)(ii) and implementing regulation 37 CFR 1.704(b). The entry also reflects additional Applicant's failure to engage in reasonable efforts to conclude prosecution of the application. See 35 U.S.C. § 154(b)(2)(C)(iii) and implementing regulations 37 CFR 1.704(c)(1)-(11).

(10) TOTAL PTA CALCULATION. This entry reflects the summation of the following entries: NONOVERLAPPING USPTO DELAYS (+/or – PTO MANUAL ADJUSTMENTS) – APPLICANT DELAYS. It is noted that the TOTAL PTA CALCULATION determined at the time of the notice of allowance will not reflect PALM entries that are entered after the entry or mailing of the notice of allowance.

The TOTAL PTA CALCULATION at the time of the notice of allowance will not have considered 35 U.S.C. § 154(b)(1)(A)(iv) and implementing regulation 37 CFR 1.702(a)(4) and 35 U.S.C. § 154(b)(1)(B) and implementing regulation 37 CFR 1.702(b) that increase the amount of PTA. Moreover, the calculation would not have considered any responses taking more than three months after the entry or mailing of notice of allowance under 37 CFR 1.704(b) or reductions under 37 CFR 1.704(c)(10) that could reduce the amount of PTA. These calculations will be included in the USPTO determination that is provided in the issue notification letter that is provided approximately three weeks prior to the issue date of the patent.

2. What do I do if I do not agree with the patent term adjustment determination?

If Applicant does not agree with the patent term adjustment determination as shown on the Notice of Allowance which is reflected on the PAIR screen, Applicant may file an application for patent term adjustment requesting reconsideration of the patent term adjustment determination and any "due care" showing. See 35 U.S.C. § 154(b)(3)(B) and 37 CFR 1.705(b) and (c). Applicant must file an application for patent term adjustment **no earlier than the date of mailing of the notice of allowance and no later than the payment of the issue fee. The application for patent term adjustment must be accompanied by the requirements enumerated in 37 CFR 1.705(b).**

If Applicant agrees with the TOTAL PTA Calculation determination shown on the Notice of Allowance which is reflected on the PAIR screen, but, believes that all or part of the term of the patent being reduced pursuant to 37 CFR 1.704(b) is due to Applicant being unable to respond within three months mailing of the Office communication and Applicant was unable to meet the deadline **in spite of all due care**, then Applicant may file an application for patent term adjustment requesting reinstatement of the period reduced pursuant to 37 CFR 1.704(b). See 37 CFR 1.705(c). Any request for reinstatement will not be granted for more than the three additional months for each reply beyond three months from the mailing of the application. Applicant(s) must file an application for patent term adjustment **no earlier than the date of mailing of the allowance and no later than the payment of the issue fee. Applicant's request for patent term adjustment requesting reinstatement of all or part of the term must comply with the requirements enumerated in 37 CFR 1.705(c).**

If patentee finds that the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent **must be filed within two (2) months of the date the patent issued and must comply with the requirements of 37 CFR 1.705(b)(1) and (2).** See 37 CFR 1.705(d).

The USPTO does not calculate and inform the applicant of the patent term adjustment based upon the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in the notice of allowance because the USPTO must know the date the patent will issue to be able to calculate the patent term adjustment based upon this provision. Thus, reconsideration of the patent term adjustment indicated in the patent as it relates to the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) is not considered a matter that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b) (provides for reconsideration of the patent term adjustment indicated in the notice of allowance). Therefore, a request for reconsideration of the patent term adjustment calculation based on the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) will be considered timely under 37 CFR 1.705(d) if filed within two months of the date the patent issued.

Because the "B" delay is not determined until the patent issues, accordingly, calculation of overlap between "A" and "B" delay will also not occur until the time the patent issues and therefore an request for reconsideration of patent term adjustment as it relates to overlapping time periods will be considered timely under 37 CFR 1.705(d). Other provisions that will be timely under

37 CFR 1.705(d) include 37 CFR 1.702(a)(4) and 1.704(c)(10), and some instances under 37 CFR 1.704(b).

3. What do I do if I have a question about PAIR or PTA calculation?

If the question is concerning how PAIR works contact the Patents Electronic Business Center (EBC) at 1-866-217-9197 (toll free) or (571) 272-4100.

If you have questions concerning the PTA determination contact the Office of Patent Legal Administration's helpline for PTA at 571-272-7702.

Last Modified: 2/12/2010 12:47:59 PM

EXHIBIT B

Patent Application Information Retrieval


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10/788,506

METHOD OF EVALUATING AN OPTION SPREAD



Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Published Documents	Address & Attorney/Agent
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Patent Term Adjustment

Filing or 371(c) Date:	02-26-2004	Overlapping Days Between {A and B} or {A and C}:	0
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	1096
A Delays:	1096	PTO Manual Adjustments:	0
B Delays:	0	Applicant Delays:	175
C Delays:	0	Total PTA Adjustments:	921

Patent Term Adjustment History

Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
87	12-09-2010	Mail Notice of Allowance			0
86	12-06-2010	Issue Revision Completed			0
85	12-06-2010	Document Verification			0
84	12-06-2010	Notice of Allowance Data Verification Completed			0
83	11-08-2010	Examiner's Amendment Communication			0
82	11-01-2010	Examiner Interview Summary Record (PTOL - 413)			0
81	11-08-2010	Notice of Allowability			0
80	11-04-2010	New or Additional Drawing Filed			0
79	09-09-2010	Miscellaneous Incoming Letter			0
78	08-24-2010	Email Notification			0
77	08-24-2010	Mail Notice of Withdrawn Action			0
76	08-18-2010	Date Forwarded to Examiner			0
75	08-18-2010	Letter Withdrawing / Vacating Office Action			0
74	07-23-2010	Electronic Review			0
73	07-23-2010	Email Notification			0
72	07-23-2010	Mail Final Rejection (PTOL - 326)			0
71	07-19-2010	Final Rejection			0
70	04-23-2010	Date Forwarded to Examiner			0
69	04-12-2010	Response after Non-Final Action			0
68	04-15-2010	Email Notification			0
67	04-15-2010	Mail Examiner Interview Summary (PTOL - 413)			0
66	04-10-2010	Examiner Interview Summary Record (PTOL - 413)			0
65	03-03-2010	Electronic Review			0
64	03-03-2010	Email Notification			0
63	03-03-2010	Mail Non-Final Rejection	3		60

62	02-26-2010	Non-Final Rejection		0
61	12-23-2009	Date Forwarded to Examiner		0
60	10-30-2009	Response after Non-Final Action	50	49
59	10-30-2009	Request for Extension of Time - Granted		0
58	11-09-2009	Email Notification		0
57	11-09-2009	Mail Examiner Interview Summary (PTOL - 413)		0
56	09-09-2009	Examiner Interview Summary Record (PTOL - 413)		0
54	11-25-2008	Information Disclosure Statement (IDS) Filed	34	29
53	07-17-2009	Email Notification		0
52	07-17-2009	Change in Power of Attorney (May Include Associate POA)		0
51	06-10-2009	Electronic Review		0
50	06-10-2009	Email Notification		0
49	06-10-2009	Mail Non-Final Rejection		0
48	06-08-2009	Non-Final Rejection		0
44	05-07-2009	Date Forwarded to Examiner		0
43	04-23-2009	Amendment Submitted/Entered with Filing of CPA/RCE		0
42	05-07-2009	Date Forwarded to Examiner		0
41	04-23-2009	Request for Continued Examination (RCE)		0
40	05-07-2009	Disposal for a RCE / CPA / R129		0
39	04-30-2009	Email Notification		0
38	04-30-2009	Mail Examiner Interview Summary (PTOL - 413)		0
37	04-21-2009	Examiner Interview Summary Record (PTOL - 413)		0
36	04-23-2009	Workflow - Request for RCE - Begin		0
35	04-02-2009	Correspondence Address Change		0
34	01-23-2009	Mail Final Rejection (PTOL - 326)		0
33	01-21-2009	Final Rejection		0
32	11-25-2008	Information Disclosure Statement considered		0
31	11-25-2008	Information Disclosure Statement (IDS) Filed		0
30	11-13-2008	Date Forwarded to Examiner		0
29	10-22-2008	Response after Non-Final Action	91	27
28	10-22-2008	Request for Extension of Time - Granted		0
27	04-23-2008	Mail Non-Final Rejection	1093	0.5
26	03-17-2008	Non-Final Rejection		0
25	05-21-2004	Information Disclosure		0

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24	01-30-2008	Case Docketed to Examiner in GAU	0
23	10-17-2007	Withdraw Flagged for 5/25	0
22	10-17-2007	Withdraw Flagged for 5/25	0
21	10-17-2007	Case Docketed to Examiner in GAU	0
20	10-15-2007	Flagged for 5/25	0
19	10-15-2007	Flagged for 5/25	0
18	10-05-2006	Case Docketed to Examiner in GAU	0
17	09-22-2006	Case Docketed to Examiner in GAU	0
16	09-12-2006	Case Docketed to Examiner in GAU	0
15	08-15-2006	IFW TSS Processing by Tech Center Complete	0
14	06-22-2006	Case Docketed to Examiner in GAU	0
13	09-27-2005	Miscellaneous Incoming Letter	0
12	12-02-2004	Correspondence Address Change	0
11	05-21-2004	Certified Translation of Foreign Priority Document	0
10.7	05-21-2004	Information Disclosure Statement (IDS) Filed	0
10	05-21-2004	Information Disclosure Statement (IDS) Filed	0
9	02-26-2004	Oath or Declaration Filed (Including Supplemental)	0
8	05-20-2004	Application Return from OIPE	0
7	05-20-2004	Application Return TO OIPE	0
6	05-20-2004	Application Dispatched from OIPE	0
5	05-20-2004	Application Is Now Complete	0
4	03-29-2004	Cleared by OIPE CSR	0
3	03-29-2004	CASE CLASSIFIED BY OIPE	0
2	03-10-2004	IFW Scan & PACR Auto Security Review	0
1	02-26-2004	Initial Exam Team nn	0
0.5	02-26-2004	Filing date	0

If you need help:

- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail EBC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).
- Send general questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).
- If you experience technical difficulties or problems with this application, please report them via e-mail to [Electronic Business Support](#) or call 1 800-786-9199.

You can suggest USPTO webpages or material you would like featured on this section by E-mail to the webmaster@uspto.gov. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.